

Remarks

Claim 14 has been amended to overcome the objection for claim informalities.

Two terminal disclaimers are enclosed with a check for the \$130.00 requisite fee to overcome the rejection for Claims 7-10 and 12-14 for obviousness-type double patenting.

Claims 7-10 and 12-14 were rejected under 35 U.S.C. 103(a) as being unpatentable in view of U.S. Patent No. 5,760,950 (Maly et al.) "Maly". It is the Examiner's position that Maly discloses the Claim 7 step of treating tissue. However, the process of treating tissue cannot be described as being carried out by Maly's microscope where there is no means for operating upon tissue to cause treatment. It is respectfully submitted that mere statement that Maly's microscope can observe "the effects of laser refractive surgery" at lines 12-13 of column 13, does not express or imply that Maly's microscope can perform laser refractive surgery, as the Examiner contends. Clearly, there is no supporting optical system to enable treatment, but only imaging (see FIG. 1 of Maly).

Maly in fact teaches away from the Examiner position that Maly can cause laser treatment to be carried out. First, Maly's optical system relies on a Nipkow type disk (210) in its optical path to enable "optical sectioning" as described at column 4, lines 57-67, column 7, lines 54-65, column 8, line 15, and column 13, line 56-62. The rotating Nipkow disk (210) has approximately 14,000 pinholes (220) which although useful for imaging provides an inefficient means to transmit laser energy to cause treatment of tissue (see column 4, lines 12-23), since it allows only a fraction of the laser energy to pass. Further, to modify Maly to remove its Nipkow disk (210) would be a complex redesign which cannot be obvious, and moreover would remove the capability to perform "optical sectioning" as taught by Maly. Also, laser surgery contended by the Examiner as being provided in Maly typically requires a controller for positioning a laser beam at a desired location in tissue, and no such controller is shown in any of Maly's figures. If it is the Examiner's contention that Maly's optical system for imaging tissue can be modified to treat tissue, then it is submitted that the Examiner is using hindsight knowledge learned from the present application, and such use of hindsight knowledge is prohibited. See In re Dow Chemical Co., 5 USPQ2d 1529, 1532 (Fed. Cir. 1988), In re Nomiya et al., 184 USPQ 607, 613 (CCPA 1975), and In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991).

Second, Maly teaches away from the Examiner's position that Maly can cause laser treatment to be carried out by statements throughout Maly supporting that its microscope observes only after surgical procedures. In fact, the statement relied upon by the Examiner at column 13, lines 12-13, in Maly actually refers to the prior sentence in the same paragraph at column 13, lines 5-10, which states that Maly's microscope has "applications including observation of"... "the timecourse of corneal-wound healing after surgical procedures for refractive changes of the cornea" (underline added), and then that "[i]n observing the effects of laser refractive surgery" depth of incisions are measurable by the Maly's microscope (see column 13, lines 12-13). Monitoring in Maly always is performed after surgery is carried out, which fails to imply that Maly's microscope performs laser surgery. This is further supported elsewhere in Maly, for example, Maly at column 8, lines 44-50, states "[a]berrant cellular spatial distributions can be detected by comparison to a normal cell distribution, for example on the anterior and posterior surfaces of the cornea. Such information is useful for examining solution toxicity, contact lens wear, recovery after surgery, wound healing, and disease processes (underline added)". Maly states at column 9, lines 5-8, that "[i]n this way, Applicants' method provides for determining changes in cell density that can occur as a result of corneal endothelial disease, contact lens wear, dystrophies, surgery, or intra-ocular lenses (underline added)". See also column 13, lines 19-21, that states "[f]or example, the time course of epithelial regrowth following laser surgery should be easy to follow (underline added)", or column 13, lines 34-35, "permitting closer observation of endothelial cell function after corneal surgery". Since Maly's microscope describes its relation to surgery as being limited to observing tissue after or following surgery, one cannot state that Maly's microscope can operate to perform surgery, especially where such microscope's optical system teaches away from its use for surgery as explained above by its reliance on a Nipkow Disk (210). If Maly's microscope could cause treatment, the Maly patent would say so.

Claim 7 describes the step of treating tissue with the aid of an illumination beam via optics, and that the imaging step utilizes at least one component of the optics of the treating step. Since Maly does not describe enabling treatment, as argued above, then the claimed optics cannot be described or even suggested in Maly, and its imaging cannot utilize any component of such optics. Thus, Maly cannot be modified, as the Examiner contends, so that imaging and treating share same optical components, where there is no

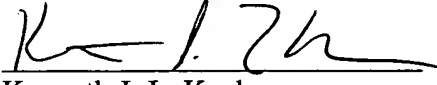
optics present in Maly used to treat tissue. Accordingly, Maly fails to teach or suggest each and every claim limitation of Claim 7, and thus Claim 7 is patentable over Maly (see MPEP 2143.03). Withdrawal of the rejection of Claim 7 and of its dependent claims is requested.

In regards to Claim 14, it cannot be said that Maly discloses both imaging and treating using at least the same objective lens, where Maly optical system (120) of FIGS. 2A and 2B although providing imaging through objective lens (290) does not describe or even suggest treatment through its objective lens (290).

It is believed the application is in condition for allowance, and a notice of allowance is respectfully solicited. A petition for a one-month extension is enclosed with a check for the petition fee.

Respectfully submitted,

Dated: September 25, 2006


Kenneth J. LuKacher
Attorney for Applicant(s)
Registration No. 38,539

South Winton Court
3136 Winton Road South, Suite 301
Rochester, New York 14623
Telephone: (585) 424-2670
Facsimile: (585) 424-6196

Enclosures: Certificate of Mailing by First Class Mail;
Petition for Extension of Time with a Check for \$60.00;
Two Terminal Disclaimers with a Check for \$130.00.